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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/933,119

08/21/2001

Makoto Inoue

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21254

7590

08/29/2006

MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA, VA 22182-3817

EXAMINER

O'CONNOR, GERALD J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,119

Applicant(s)

Inoue et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on April 19, 2006 (RCE w/Amdt).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3, 5, 7, and 8 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 5, 7, and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on November 30, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 19, 2006 has been entered.

Preliminary Remarks

2. This Office action responds to the amendment and arguments filed by applicant on April 19, 2006 in reply to the previous Office action on the merits, mailed October 20, 2005.

3. The amendment of claims 3, 5, 7, and 8 by applicant in the reply filed on April 19, 2006 is hereby acknowledged.

4. The cancellation of claims 1, 2, 4, 6, and 22-30 by applicant in the reply filed on April 19, 2006 is hereby acknowledged.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 3, 5, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Gardner et al. (US 5,758,327).

Gardner et al. disclose a system for ordering items comprising: a server for controlling data communication with a plurality of terminals via a network; a database accessible by the server comprising: a merchandise master which stores information on items offered from a plurality of dealers to a plurality of customers according to item numbers unique to each item; and, a merchandise assortment related master which stores a list of traded items and the item numbers among the items stored in the merchandise master agreed upon between the customer

and the dealer as merchandise assortment related information according to each purchasing unit of the customer and each dealer who offers the item to the customer; and, a terminal for submitting to the server an ordering request for ordering at least one item from a user who belongs to a purchasing unit; wherein the server comprises an item specific order controller for specifying, for each item in the ordering request, a dealer who offers the item, based on the merchandise assortment related information of the purchasing unit to which the user belongs; wherein the merchandise assortment related master stores the merchandise assortment related information groups for each of the dealers in a state in which item numbers of items purchased by the customer are not duplicated by a plurality of dealers; wherein the item specific order controller comprises: a function for determining a purchasing unit of a user who accessed from the terminal and specifying the merchandise assortment related information group for the purchasing unit, based on the determined purchasing unit; a function for displaying an electronic catalog comprising a list of all items stored in the specified merchandise related information group on the terminal; a function for, upon the user selecting an item, specifying the unique merchandise related information of the selected item number, among the merchandise related information group; and, a function for specifying a dealer of the item number based on the specified merchandise assortment related information.

Regarding claim 5, in the system of Gardner et al., the item specific ordering controller further comprises: a function for adding an item selected by the user to an ordering request group when an approval standard of the selected item and an approval standard of a previously selected

item are the same; and, a function for rejecting addition of the selected item to the order request group when the approval standard of the selected item and the approval standard of the previously selected item are different, and for prompting group-ordering with different dealers by the same approval standard without accepting addition of items having different approval standards.

Response to Arguments

7. Applicant's arguments filed April 19, 2006 have been fully considered but they are not deemed persuasive.

8. Regarding the argument that the system of Gardner et al. fails to include that the items purchased by the customer are not duplicated by a plurality of dealers, such that the system can automatically specify the dealer for each item selected by the user for purchasing, the system of The system of Gardner et al. indeed includes that the items purchased by the customer are not duplicated by a plurality of dealers, such that the system can automatically specify the dealer for each item selected by the user for purchasing. See, for example, column 5, lines 35-39.

9. Regarding the argument that the system of Gardner et al. fails to include that no selection of a dealer is made by price comparison or condition comparison, such that the dealer is automatically and forcibly specified at the time of issuing an order following predetermined

rules, the system of Gardner et al. indeed includes that no selection of a dealer is made by price comparison or condition comparison, such that the dealer is automatically and forcibly specified at the time of issuing an order following predetermined rules. See, for example, column 5, line 13, to column 6, line 13.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to the disclosure.

11. All rejected claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.


The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at **(571) 272-6771**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300**. Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

August 24, 2006

 8/24/06

Gerald J. O'Connor

Primary Examiner

Group Art Unit 3627